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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/627,426	07/24/2003	Edward B. Knudson	UV-34 Cont 4	2337
75563	7590	02/06/2008		
ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704			EXAMINER ONUAKU, CHRISTOPHER O	
			ART UNIT 2621	PAPER NUMBER
			MAIL DATE 02/06/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/627,426	Applicant(s) KNUDSON ET AL.	
	Examiner Christopher Onuaku	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 24 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>11/19/07</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4 are rejected under 35 U.S.C. 102(e) as being anticipated by
Horlander et al (US 7,017,171).

Regarding claim 1, Horlander et al systems for communicating between multiple electronic devices, such as consumer electronic devices, via interconnections such as digital data buses, comprising:

a) means for receiving television program guide information for use in the interactive television program guide, and means for selecting a program for recording from the interactive television program guide (see Fig.1, DSS 170 and the processing of the electronic program guide; col.9, line 64 to col.10, line 8; and col.2, lines 7-13);

b) means for determining whether the selected program is copy protected (see Fig.1; DSS copyright protection processing; col.7, lines 43-50, and col.9, line 64 to col.10, line 25); and

c) means for displaying a message informing a user that the selected program may not be recorded upon determining that the selected is copy protected (see col.13, lines 40-48).

Regarding claim 2, the claimed limitations of claim 2 are accommodated in the discussions of claim 1 above.

Regarding claim 3, the claimed limitations of claim 2 are accommodated in the discussions of claim 1 above, including a video recorder (see VCR 100 of Fig.1 of Horlander).

Regarding claim 4, the claimed limitations of claim 4 are accommodated in the discussions of claim 1 above, the claimed machine-readable medium (see the play/record circuitry 101 of VCR 100 in Fig.1 of Horlander).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 5-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Horlander et al in view of Wonfor et al (US 6,381,747).

Regarding claim 5, Horlander discloses the claimed limitations of claim 5, including providing the selected program without copy protection (see col31, lines 53-58 and col.32, lines 52-56) here if it is legal to copy the bit stream the source device instructs the VCR to turn on its DAV receiver and to go into the record mode, and additionally DSS checks the copy protect mode of the video bit stream and determines if it is permissible to make a copy. If digital copies are permitted then the default device hails for the DAV bus.

Horlander fails to explicitly disclose means for displaying the interactive television program guide, and means for removing the copy protection from the selected program.

Wonfor et al teach a method of controlling copy protection in digital video networks where it is desired to copy protect an analog or digital video output signal associated with a digital video network, comprising displaying the interactive television program guide (see col.3, lines 8-10), and removing the copy protection from the selected program (see col.7, line 60 to col.8, line 8). Displaying the interactive television program guide provides the desirable advantage of allowing the user the time to preview the program guide to see what programs are available before selecting a desired program, and removing the copy protection from the selected program provides the desirable advantage of allowing the user to have access to the programs in order to copy desired programs.

It, therefore, would have been obvious to modify Horlander by realizing Horlander with the means for displaying the interactive television program guide, as taught by

Wonfor, since this provides the desirable advantage of allowing the user the time to preview the program guide to see what programs are available before selecting a desired program, and also would have been obvious to modify Horlander by realizing Horlander with the means for removing the copy protection from the selected program, as taught by Wonfor, since this provides the desirable advantage of allowing the user to have access to the programs in order to copy desired programs, for example.

Furthermore, Horlander fails to explicitly disclose means for offering the selected program for purchase at a price for the program without copy protection when the program is selected for recording, means for offering the selected program for purchase at a price for the program with copy protection when the program is selected for viewing, and means for providing the selected program with copy protection when the program is purchased at the price for the program with copy protection. However, this would have been an obvious engineering design consideration depending on the circuit at hand.

Regarding claim 6, Horlander et al and Wonfor et al fail to explicitly disclose wherein the price for the program without copy protection is more than the price for the program with copy protection. However, this would have been an obvious engineering design consideration depending on circuit at hand.

Regarding claim 7, the claimed limitations of claim 7 are accommodated in the discussions of claim 5 above.

Regarding claim 8, the claimed limitations of claim 8 are accommodated in the discussions of claim 6 above.

Regarding claim 9, the claimed limitations of claim 9 are accommodated in the discussions of claim 5 above; except, wherein the control circuitry directs the tuner circuitry to tune to the selected program with copy protection (see Horlander et al, col.4, lines 44-50, and col.13, lines 13-23). Horlander and Wonfor fail to explicitly disclose wherein the control circuitry is configured to direct the display circuitry to display a message offering the user the selected program for purchase at a price for the program without/with copy protection when the program is selected for recording/viewing, respectively. However, this would have been an obvious engineering design consideration depending on the circuit at hand.

Regarding claim 10, the claimed limitations of claim 10 are accommodated in the discussions of claim 6 above.

Regarding claim 11, the claimed limitations of claim 11 are accommodated in the discussions of claim 5 above.

Regarding claim 12, the claimed limitations of claim 12 are accommodated in the discussions of claim 6 above.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Onuaku whose telephone number is 571-272-7379. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

COO

1/23/08.


JOHN MILLER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600